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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/981,360	12/18/1997	Kari Kirjavainen	U 011574-0	3410

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/981,360

Applicant(s)

KIRJAVAINEN ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 112 rejections of claims 11 and 12 of record in the Office Action mailed March 15, 2005, Pages 3-4 Paragraph 6, have been withdrawn due to Applicant's amendments in the Paper filed June 10, 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-12, 15, and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claims 1, 15, and 22, the limitation "self" adhered renders the claims vague and indefinite. It is not understood how the foamed plastic is adheres itself to the base layer and innermost layer. Does this limitation merely mean that the layer has adhesive properties and does not require an adhesive layer between it and the layers it is adhered to? Or, does "self" adhered mean that the foamed plastic is tacky and immediately sticks to the other layers without any treatment or curing like a pressure sensitive adhesive? Or does the foamed plastic some how able to position itself in contacting relation with the other layers and then adheres to the other layers? Clarification is required.

Claims 2-12 and 18-21 are dependent on claims 1, 15, or 22 and therefore are rejected based on the fact that they also include the indefinite limitation described above.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The 35 U.S.C. 102 rejections of claims 1-2, 5-6, 8, 15, 18-19 and 21-22 as anticipated by Maimets are repeated for the

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reasons set forth in the previous Office Action mailed March 15, 2005, Pages 4-6 Paragraph 7.

Regarding the newly added limitation in claims 1, 15, and 22, that the foamed plastic is "self" adhered to the base layer and the innermost layer, the broadest reasonable interpretation in light of the specification of "self" adhered is that the foamed plastic has adhesive properties and does not require adhesive layers between itself and the base layer and/or the innermost layer. In this case, the foamed plastic gasket, which includes the grout that is present within the foamed plastic carrier, has adhesive properties and forms a bond with the base layer and innermost layer without the need for an additional adhesive layer.

5. The 35 U.S.C. 103 rejections of claims 3-4 over Maimets in view of Bast are repeated for the reasons set forth in the previous Office Action mailed March 15, 2005, Pages 7-8 Paragraph 8.

6. The 35 U.S.C. 103 rejections of claims 7, 9 and 20 over Maimets in view of Stanley are repeated for the reasons set forth in the previous Office Action mailed March 15, 2005, Pages 8-10 Paragraph 9.

7. The 35 U.S.C. 103 rejection of claim 10 over Maimets in view of Stanley and Donuiff is repeated for the reasons set forth in the previous Office Action mailed March 15, 2005, Pages 10-12 Paragraph 10.

8. The 35 U.S.C. 103 rejection of claim 11 over Maimets in view of Cook is repeated for the reasons set forth in the previous Office Action mailed March 15, 2005, Pages 12-13 Paragraph 11.

9. The 35 U.S.C. 103 rejection of claim 12 over Maimets in view of Hunter is repeated for the reasons set forth in the previous Office Action mailed March 15, 2005, Pages 13-14 Paragraph 12.

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's arguments regarding the 35 U.S.C. 112 rejections of claims 11 and 12 of record have been considered but are moot since the rejections have been withdrawn.

11. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1-2, 5-6, 8, 15, 18-19, and 21-22 as

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anticipated by Maimets have been fully considered but they are not persuasive.

In response to Applicant's argument that Maimets fails to teach that the foamed plastic adhering tie layer "is extruded simultaneously with the innermost layer against the base layer, the limitation is a process limitation and no evidence has been provided showing that this particular process produces a patentably different article from Maimets. The porous gasket of Maimets that is formed of a foamed plastic and is bonded to the innermost and base layers does not require an adhesive layer. The conduit taught by Maimets includes a foamed plastic layer bonded directly to a base layer and innermost layer without any intervening adhesive. Therefore, the conduit of Maimets has the same final structure as the claimed invention. Once the examiner provides a rationale tending to show that the claimed product appears to be the same to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

In response to Applicant's argument that Maimets fails to teach that the foamed plastic layer "self" adheres to the inner and base layers, the broadest reasonable interpretation in light

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of the specification of "self" adhered is that the foamed plastic has adhesive properties and does not require adhesive layers between itself and the base layer and/or the innermost layer. In this case, the foamed plastic gasket, which includes the grout that is present within the foamed plastic carrier, has adhesive properties and forms a bond with the base layer and innermost layer without the need for an additional adhesive layer.

In response to Applicant's argument that the gasket of Maimets is a grout carrier medium and not a foamed plastic having "self" adhering properties, the gasket is the a foamed plastic filled with grout and the combined properties of the foamed plastic and grout form a foamed plastic with adhesive properties that enable the foamed plastic to bond to the base layer and the innermost layer without the need for other adhesives. Therefore, the gasket of Maimets meets the structural limitations of the claimed invention and the process limitations are discussed above.

In response to Applicant's argument that the gasket of Maimets fails to teach "meltingly extruded simultaneously with the innermost layer against the base layer", the gasket of Maimets includes the foamed plastic and the grout filler that is bonded to the innermost layer and the base layer and therefore

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there is an interbonding by interfusion present in the Maimets teaching.

In response to Applicant's argument that the claimed invention only teaches one tying layer and the Maimets patent does not, the gasket of Maimets is one tying layer comprising a foamed plastic acting as a carrier and therefore containing the grout within the layer. Therefore, the gasket and grout combination taught in Maimets is one tying layer in the broadly claimed manner of the claimed invention.

12. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 3-4, 7, 9-12, and 20 over Maimets in view of Bast, Stanley, Donuiff, Cook, and/or Hunter of record have been fully considered but are not persuasive for the same reasons as presented above with regards to the 35 U.S.C. 102 rejections.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

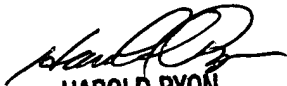
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772
CPB
CPB
July 26, 2005


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

7/29/05